

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-23 are pending in the application, with claims 1, 10, 18 and 23 being the independent claims. Claim 1 has been amended. New claim 23 is added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the following amendment and remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Applicant's representative thanks the Examiner for the courtesies extended during the personal interview on August 23, 2005. During the interview, Applicant's representatives argued that neither the Naylor patent, nor the Motson patent, alone or in combination, suggest the claimed invention. Considering Applicant's arguments, the Examiner agreed that, upon initial review, the combination fails to teach the inventions recited in independent claims 10 and 18. The Examiner requested that Applicant file a response to the outstanding Office Action so that the Examiner could reconsider the rejection of these claims. Agreement was not reached with respect to independent claim 1.

Rejection of Claims 1-4, 8 and 18-20 under 35 U.S.C. § 102(b)

Claims 1-4, 8 and 18-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,678,204 to Naylor (the "Naylor patent"). The Examiner argues that cover 10 of the Naylor patent has a similar shape to the claimed invention, including a base 14 and biased arms 16 and 18. (Office Action at p. 2). Additionally, the Examiner argues that the article 10 of the Naylor patent is able to perform/function in the same manner as the claimed invention. *Id.* Applicant traverses this rejection.

The Naylor patent does not disclose "an article for holding a device" as recited in independent claims 1 and 18, but rather a "cover 10 for a transmitter 12." (col. 1, ln. 59-60). The Naylor patent discloses that "[t]he transmitter 12 is frequently carried around sometimes causing accidentally [sic] activation of one of the actuator buttons 26. To prevent this from happening the cover 10 is engaged with the transmitter 12 with inner surface 15 of the base portion 14 in abutting, superposed relationship." (col. 2, ln. 9-13). See also Figs. 14 and 15. There is no suggestion in Naylor to use cover 10 to hold an electronic device in a position of accessibility. On the contrary, the Naylor patent teaches using cover 10 to prevent access to an electronic device. For at least this reason, cover 10 of the Naylor patent is not able to perform/function in the same manner as the claimed invention.

Further, independent claim 18 recites "means attached to said base for removably securing said article to a surface" and independent claim 1 has been amended to recite "a fastener connected to said base." As discussed in paragraph 18 of the specification, the present invention may include "a fastener for attaching the device holder to a surface

such as an automobile dashboard. This fastener may be a hook and loop fastener, a mechanical fastener or some other means of fastening the device holder to a surface." There is no disclosure in the Naylor patent of a fastener or other means attached to cover 10 for removably securing cover 10 to a surface. For at least this reason, the claimed invention is not anticipated by the Naylor patent. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131.

Accordingly, for at least the above reasons, independent claim 1, as amended, and independent claim 18, and claims 2-4, 8 and 19-20 which depend therefrom, are patentable. Applicant respectfully requests that the Examiner reconsider the rejection of these claims and that this rejection be withdrawn.

Rejection of Claims 5-7, 9 and 21-22 under 35 U.S.C. § 103(a)

Claims 5, 9 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Naylor patent in view of U.S. Patent No. 6,179,122 to Moncrief et al. ("the Moncrief patent"). Claim 6 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Naylor patent in view of U.S. Patent no. 4,991,817 to Von Kleist et al. ("the Von Kleist patent"). Claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Naylor patent in view of U.S. Patent No. 6,382,448 to Yuhara et al ("the Yuhara patent").

Claims 5-7, 9 and 21-22 depend from and add further limitations to independent claims 1 and 18. Accordingly, for at least the reasons stated above with respect to

independent claims 1 and 18, claims 5-7, 9 and 21-22 are patentable. Applicant respectfully requests that the Examiner reconsider the rejections of these claims and that such rejections be withdrawn.

Rejection of Claims 10-17 under 35 U.S.C. § 103(a)

Claims 10-13 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Naylor patent in view of U.S. Patent No. 6,264,029 to Motson ("the Motson patent"). Claims 14 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Naylor patent in view of the Moncrief patent, further in view of the Motson patent. Claim 15 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Naylor patent in view of the Von Kleist patent, further in view of the Motson patent. The Examiner argues that the Motson patent "suggests that a holder for an electronic device may be attached inside of a notebook . . . Accordingly, it would have been obvious in view of Motson to have provided the article 10 [of the Naylor patent] in a notebook." (Office Action at p. 5). Applicant traverses these rejections.

To establish a *prima facie* case of obviousness the references, alone, or in combination, must teach or suggest all claim limitations. M.P.E.P. § 2142. Additionally, there must be some suggestion or motivation to combine reference teachings. M.P.E.P. § 2142. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). There must be some reason for the combination other than hindsight gleaned from the invention disclosure. *Interconnect Planning Corp. v. Feil*,

774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d at 1266, 23 U.S.P.Q.2d at 1784; *see also In re Pleuddemann*, 910 F.2d at 828, 15 U.S.P.Q.2d at 1742; *In re Vaeck*, 947 F.2d at 493, 20 U.S.P.Q.2d at 1442.

The Examiner has failed to establish a *prima facie* case of obviousness. The combination of the Naylor patent and the Motson patent does not result in the claimed invention.

As discussed above, there is no suggestion in Naylor to use cover 10 to hold an electronic device in a position of accessibility. On the contrary, the Naylor patent teaches using cover 10 to prevent access to an electronic device. The Naylor patent discloses that "[t]he transmitter 12 is frequently carried around sometimes causing accidentally [sic] activation of one of the actuator buttons 26. To prevent this from happening the cover 10 is engaged with the transmitter 12 with inner surface 15 of the base portion 14 in abutting, superposed relationship." (col. 2, ln. 9-13). See also Figs. 14 and 15. Accordingly, the Naylor patent does not disclose "an article for holding a device," as required by independent claim 10.

The Motson patent, on the other hand, does disclose an article for holding an electronic device in a position of accessibility. When held by adjustable clamp 28 of Motson, the actuator buttons of an electronic device are accessible, not covered. See Fig. 1. However, while the Motson patent discloses an adjustable clamp 28 secured to a foldable case 12 for holding an electronic device, the adjustable clamp 28 in Motson,

unlike the claimed invention, utilizes a elastic member 52 and movable brackets 30 and 32. (col. 3, ln. 6-8). See also Fig. 4 and 5.

Absent impermissible hindsight based on the pending application, one of ordinary skill would not be motivated to replace the adjustable clamp 28 of Motson with cover 10 of Naylor, for at least the reason that Naylor teaches an arrangement which would prevent holding an electronic device in a position of accessibility. When held by adjustable clamp 28 of Motson, the actuator buttons of an electronic device are face up and accessible to a user. See Fig. 1. Pursuant to the Naylor patent, however, a device is engaged in cover 10 face down, such that the actuator buttons are not accessible to a user. Accordingly, adjustable clamp 28 and cover 10 are not interchangeable, as these devices serve opposite purposes. Rather, if one of ordinary skill in the art where to combine the teachings of Naylor and Motson, the result would be the use of both a cover 10 as disclosed in Naylor, to prevent accidental activation of the actuator buttons on an electronic device, and the adjustable clamp 28 of Motson, to hold the covered electronic device in a foldable case. Removal of the cover 10 of Naylor would be required to gain access to the electronic device while held in the adjustable clamp 28 of Motson. This combination does not result in the claimed invention for at least the reason that there is no suggestion or motivation for an article for holding a device, having the claimed structure, "*connected* to said notebook," as required by independent claim 10.

For at least this reason, independent claim 10, and claims 11-17 which depend therefrom, are patentable and Applicant respectfully requests that the Examiner reconsider the rejections of these claims and that such rejections be withdrawn.

New Independent Claim 23

New independent claim 23 recites an article for holding a device comprising (1) a base, (2) a first arm connected to said base at a first connection point on said base, wherein said first arm extends away from said base and a distal end of said first arm curves in one direction and then curves in a direction opposite thereto, and (3) a second arm connected to said base, opposite to said first arm, at a second connection point on said base, wherein said second arm extends away from said base and a distal end of said second arm curves in one direction and then curves in a direction opposite thereto. New independent claim 23 further recites that (1) said first arm and said second arm are biased towards each other, (2) said first connection point on said base and said second connection point on said base are not moveable relative to each other, and (3) said first arm and said second arm deflect to receive and hold said device such that a user can operate said device without removing said device from said article. None of the cited art discloses and/or provides motivation or suggestion for the invention recited in new independent claim 23.

As discussed above, there is no suggestion in Naylor to use cover 10 to hold an electronic device in a position of accessibility. On the contrary, the Naylor patent teaches using cover 10 to prevent access to an electronic device. The Naylor patent discloses that "[t]he transmitter 12 is frequently carried around sometimes causing accidentally [sic] activation of one of the actuator buttons 26. To prevent this from happening the cover 10 is engaged with the transmitter 12 with inner surface 15 of the base portion 14 in abutting, superposed relationship." (col. 2, ln. 9-13). See also Figs. 14 and 15. Accordingly, the Naylor patent does not disclose "an article for holding a device

... [wherein] said first arm and said second arm deflect to receive and hold said device such that a user can operate said device without removing said device from said article," as required by new independent claim 23. For at least this reason, new independent claim 23 is patentable and allowance thereof is respectfully requested.

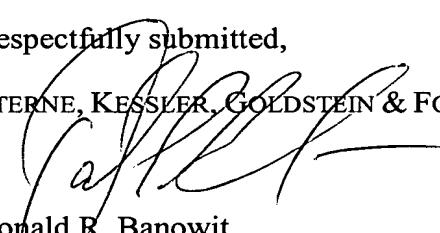
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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